

## **REMARKS**

Claims 1-9 stand rejected. By this paper, Claims 1 and 7 are amended. Claims 2, 8, and 9 are cancelled. The amendments add no new matter. Claims 1-7 are presented for consideration and further examination in view of the following remarks.

### Rejection of Claims 1-9 under Kaehler and Liska

In the Office Action, the Examiner rejected Claims 1, 2, and 4-9 under 35 U.S.C. § 102(b) as being anticipated by German Patent No. 704518 (Kaehler). Claims 1, 5, and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,041,913 (Liska). Dependent Claims 2-4 were rejected as being obvious under 35 U.S.C. § 103(a) over Kaehler in view of the knowledge of one skilled in the art. Dependent Claim 2 was rejected as being obvious under 35 U.S.C. § 103(a) over Liska in view of the knowledge of one skilled in the art. In making these rejections, the Examiner stated that “the prior art discloses a bolt as claimed that is also inherently capable of being broken. . . . It has been held that the recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform.” Applicant respectfully traverses these grounds for rejection.

### Independent Claims 1 and 7

Independent Claims 1 and 7 have been amended to recite the limitation found in original Claim 2, which specifies that the bracing bolt is strained to its yielding point. Initially, the Applicant respectfully submits that this recitation describes the *structure* of the claimed bracing arrangement, and not simply an intended use of the arrangement. The language of these claims requires that the bracing bolt “is strained.” Thus, these claims are limited to devices with a bracing bolt actually in the claimed strained configuration.

The Examiner acknowledges that neither Kaehler nor Liska discloses a bracing bolt configured in this manner. However, the Examiner argues that such an arrangement is “within the intended use of” or “obvious if not inherent” in Kaehler and also as obvious over the structure of Liska.

Turning first to Liska, it may be noted that this reference has nothing to do with overload protection for a bracing arrangement. This can be seen by the fact that the "bracing bolt" 50 of Liska has a knurled knob for finger tightening. This makes sense in the context of Liska where the fastener is used for closing a lid or panel on a metal case (see column 2, lines 8-10). In the devices contemplated by Liska, the bolt 50 could never be strained to its yielding point by hand, and there is no reason for anyone to think it could or should exist in such a strained configuration as claimed. Liska thus does not anticipate or render obvious Claims 1 and 7 as amended.

Turning now to Kaehler, this reference also does not relate to overload protection. Kaehler describes a general bolt and sleeve bracing arrangement, noting many benefits of this arrangement over mere single bolt bracing. With regard to this reference, the Examiner notes that "a force that separates f and g will press g against h whereby compression in d against f will inherently be reduced and will inherently break the bolt if further increased." However, because the bracing bolt "a" of Kaehler is not strained to its yield point as claimed, the force required to break the screw "a" is not predictable. Since it is impossible to anticipate the ultimate strength of the screw material within technically useful limits, the connections disclosed in Kaehler are not suitable to provide overload protection in the manner claimed. Instead, these connections will fail at an unpredictable point.

The Examiner hints that the claimed bracing bolt strain may be inherent in Kaehler. However, inherency requires more than a mere possibility that disclosed structure *may be* configured in the claimed manner. Instead, to establish inherency, it must be shown "that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Despite the fact that the Kaehler bracing bolt *could* be strained to the yield point, it is not necessary, and due to the sleeve and screw load sharing described in the reference, Kaehler teaches that it is not so strained.

By virtue of the claimed configuration, and as mentioned in Applicant's specification, "[i]n normal operation, the power flow and/or working load goes effectively only through the sleeve, the sleeve clamping device and the two elements to be clamped. In case of overload, the power flows effectively only through the bracing bolt and the two elements to be clamped and

then leads to the break-off of the bracing bolt, so that other machine elements are not damaged and expensive repairs can be avoided.” In contrast, Kaehler discloses a system in which the operating load is distributed between the screw and the sleeve. This cannot provide the benefits of the invention where the bracing bolt is strained to its yielding point. Applicant respectfully submits that Kaehler fails to disclose a system providing separate load paths for normal operating and overload cases. Accordingly, because the cited references do not disclose each and every element of Claims 1 and 7, Applicant respectfully submits that the rejection of these independent claims has been overcome.

### Claim 3

The Examiner has stated that it would have been an obvious design choice to “make the [bracing bolt] more elastic than the sleeve. . . inasmuch as one of ordinary skill in the art would recognize that the prior art can function as intended with first braced elements of more elasticity than the sleeve.” Applicant respectfully submits, however, that the Examiner has not provided a rationale explaining why one of skill in the art would have made the *bracing bolt* more elastic than the sleeve. Applicant further submits that the claimed material qualities have a functional significance far beyond a simple matter of design choice. In the context of the claimed configuration, providing a bolt which is more elastic than the sleeve facilitates elongation of the bolt and separation of the sleeve from the bracing in overload situations. (See paragraphs [0023], [0028]). The prior art does not show or suggest a configuration in which a relative greater elasticity of the bolt over the sleeve would be a desirable characteristic, much less a configuration as claimed in Claim 1 from which Claim 3 indirectly depends.

### The Dependent Claims

Claims 2-6, 8, and 9 depend directly or indirectly from Claim 1 and, thus, are patentable for at least the same reasons that the claim from which they depend is patentable over the applied art. Therefore, allowance of Claims 1-9 is respectfully requested.

### No Disclaimers or Disavowals

**Application No.:** 10/549,651  
**Filing Date:** January 8, 2007

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

### **CONCLUSION**

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Any remarks in support of patentability of one claim should not be imputed to any other claim in this or a related application, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on solely that portion; rather, patentability must rest on each claim taken as a whole.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art discloses or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter.

The undersigned has made a good faith effort to respond to all of the noted rejections and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if an issue requires clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve any such issue promptly.

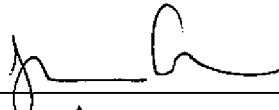
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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